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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JERRY DUNIETZ, NATHAN LEWIS, and JASON HILLS

Appeal 2009-004111¹
Application 09/552,262
Technology Center 2100

Decided: November 23, 2009

Before JOSEPH L. DIXON, JEAN R. HOMERE, and JAMES R. HUGHES,
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ An oral hearing was held in this appeal on November 4, 2009.

I. STATEMENT OF THE CASE

The Patent Examiner rejects claims 1-35. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

A. INVENTION

The invention at issue on appeal relates to the display of electronic documents and, in particular, to a technique for pre-computing and encoding an electronic document to minimize run-time computational requirements for parsing and search operations. (Spec. 1.)

B. ILLUSTRATIVE CLAIM

Claim 1, which further illustrates the invention, follows.

1. A method for encoding an electronic document having markup language content, wherein the document includes at least one tag and an associated content, the method comprising the steps of:
 - (a) separating the tag from the content with a separation variable;
 - (b) replacing the tag with an alias, wherein the alias is a pre-defined representation for the tag; and
 - (c) inserting at least one flag within the tag to form an encode tag structure, wherein a first encoded document is formed.

C. REFERENCES

The Examiner relies on the following references as evidence:

Tada	5,745,745	Apr. 28, 1998
Carus	6,035,268	Mar. 7, 2000

Open eBook™ Publication Structure 1.0 (Sept. 16, 1999) (hereinafter “open eBook”).

D. REJECTIONS

Claims 1, 2, 5, 7, 9, and 16-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tada.

Claims 3, 4, 8, 22, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tada in view of Open eBook.

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Tada as applied to claim 1 above, and further in view of Carus.

Claims 10 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tada, in view of Carus.

Claims 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tada.

Claims 14 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Open eBook.

Claims 24-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Open eBook in view of Tada.

II. ISSUE

Have Appellants shown error in the Examiner’s initial showing of obviousness for each of the separate rejections?

III. PRINCIPLES OF LAW

Prima Facie Case of Unpatentability

The allocation of burden requires that the United States Patent and Trademark Office (USPTO) produce the factual basis for its rejection of an application under 35 U.S.C. §§ 102 and 103. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967)). The Examiner bears the initial burden of presenting a prima facie case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Appellants have the opportunity on appeal to the Board of Patent Appeals and Interferences (BPAI) to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

Obviousness

A claimed invention is not patentable if the subject matter of the claimed invention would have been obvious to a person having ordinary skill in the art. 35 U.S.C. § 103(a); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13 (1966). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art. *Graham*, 383 U.S. at 17-18. *See also KSR*, 550 U.S. at 407 ("While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.")

IV. ANALYSIS

We address the claims in the order addressed in Appellants' Brief.

With respect to independent claim 1, Appellants argue that Tada fails to disclose or suggest claimed features of "inserting at least one flag within the tag to form an encode tag structure" as recited in independent claim 1. (App. Br. 15-16.) Appellants argue that the relied upon text of Tada teaches that the start tag is replaced by the control code "a." Appellants also assert that the Examiner maintains the control code is the flag, and if so, then the flag is not inserted within the tag to form an encode tag structure since Tada teaches replacing the tag with the flag. (App. Br. 16.) We note that the Examiner does not respond to Appellants' arguments set forth at pages 14 through 17 of the Appeal Brief. Since the Examiner has not responded Appellants' argument which sets forth a reasonable interpretation of the teachings of Tada, we find that Appellants have shown error in the Examiner's initial showing of obviousness of independent claim 1. Therefore, we will additionally reverse the rejection of dependent claims 2, 5, 7, and 9 as containing the same deficient rejection as discussed above with respect to independent claim 1. We also note that although claim 9 is an independent claim directed to a different statutory class of invention, the rejection would similarly be deficient for the reasons discussed above.

With respect to independent claim 16, Appellants argue that Tada fails to disclose or suggest "inserting at least one code character into the electronic document to separate markup language from content." (App. Br. 17.) Appellants maintain that the Examiner is using the present application as a blueprint to reject the present claim(s) (App. Br. 17-18), but Appellants do not specifically address the Examiner's stated correlation of the teachings

and suggestions of Tada. Therefore, Appellants' argument is not persuasive of error in the Examiner's initial showing of obviousness. Appellants further argue that Tada fails to disclose or suggest the claimed feature of "replacing the tag with an alias, whereby the tag may be readily identified during run-time parsing of the document" as recited in claim 16. (App. Br. 18.)

Appellants contend that the relied upon portion of Tada at column 22 merely teaches replacing content such as a character string rather than replacing a tag with an alias. (App. Br. 18). Appellants have identified no express definition for the "tag" or the "alias." We agree with the Examiner's finding that Tada teaches and fairly suggests "replacing the tag with the alias," and specifically that Tada teaches replacing the start tag by the control code "α." Appellants present no persuasive argument to the contrary. Therefore, Appellants have not shown error in the Examiner's initial showing of obviousness of independent claim 16 and dependent claims 17-18 which are grouped therewith due to lack of separate arguments for patentability.

With respect to independent claim 19, Appellants argue that Tada fails to disclose or suggest "at least one tag having encoded therein a predetermined integer alias for the tag" as recited in independent claim 19. (App. Br. 19.) Appellants have not identified why the use of the specific control code "α" would not have taught or suggested the "predefined integer alias for the tag" as claimed. Therefore, Appellants' argument is unpersuasive of error in the Examiner's initial showing of obviousness.

Appellants further argue that Tada fails to disclose or suggest the claimed feature of "a code separating the tag from the content portion, whereby the content and markup within the documents may be readily parsed at run-time" as recited in independent claim 19. (App. Br. 20.)

Appellants have not defined or identified a definition of the code separating the tag from the content portion to limit the Examiner's interpretation thereof. We find Tada teaches delimiters which set off and define the tag and the content therein as shown in column 22 with the start character and the end character. Therefore, Appellants' argument is not persuasive of error in the Examiner's initial showing of obviousness of independent claim 19, and dependent claim 20.

With respect to dependent claims 3, 4, 8, 22, and 23, Appellants have not set forth separate arguments for patentability and rely upon the arguments advanced with respect to independent claim 1 and independent claim 19. Therefore, we will reverse the rejection of claims 3, 4, and 8 claims of standing with independent claim 1 and sustain the rejection of dependent claims 22 and 23 falling with their respective independent claim 19. (App. Br. 20.)

With respect to dependent claims 6, the Examiner relies upon the teachings of Carus concerning comparing the left and right terms to determine if they are part of a single word, but the Examiner does not identify how Carus remedies the above noted deficiency in independent claim 1. Appellants rely upon the argument advanced with respect to independent claim 1 (even though Appellants identify Tada and open eBook as the combination). We agree with Appellants that Carus (the correct secondary reference) does not remedy the deficiencies in Tada, and we find that Appellants have identified error in the Examiner's initial showing of obviousness of dependent claims 6. (App. Br. 21.)

With respect to independent claim 10, Appellants argue that the determination of concatenation between successive characters, a break

between successive characters, or an unknown transition between successive characters does not disclose, teach, or suggest the claimed feature of "identifying a tag between a left and a right term was in a document" and "determining whether the tag is within a single word." (App. Br. 21-22.)

We find Appellants' arguments unavailing since we find Carus teaches and fairly suggests identifying a tag between a left and right term within a document and determining whether the tag is within a single word in columns 2 and 3. Therefore, we find Appellants' arguments unpersuasive of error in the Examiner's initial showing of obviousness of independent claim 10 and dependent claim 11 which is grouped therewith since Appellants have not set forth separate arguments for patentability thereof.

With respect to independent claim 12, Appellants argue that Tada fails to teach the claimed element, "if the portion is not to be displayed for viewing, inserting a no search flag in association with the portion, whereby in no search field may be readily identified and skipped during a run-time linear search." (App. Br. 22.) The Examiner admits at page 18 of the Answer that Tada does not teach a no search flag is conditionally inserted based upon determining whether the portion is to be displayed for viewing. What the Examiner concludes is that it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tada "to have created the claimed invention." (Ans. 18.) Here, the Examiner appears to speculate and to invite a skilled artisan to create and to invent rather than to merely modify the teachings of Tada based upon what was known in the prior art at the time of the invention based upon some objective evidence of administrative record. We find no objective teaching with which to make the desired modification the Examiner proposes in the record

before us. Therefore, Appellants have shown error in the Examiner's stated rejection, and we are constrained to reverse the rejection of independent claim 12 and its dependent claim 13 which has not been argued separately.

With respect to independent claim 14, Appellants contend that "the reference Open eBook does not disclose, teach, or suggest the claimed feature of "replacing *part* of the URL with the reference string and a flag for the file." (App. Br. 23.) From our review of the Examiner's stated rejection at pages 18-20 of the Answer, we find the Examiner does not specifically address this limitation in the statement of the rejection, and the Examiner does not address independent claim 14 in any of the responsive arguments in the Answer. Therefore, Appellants have shown error in the Examiner's proffered original presentation of a prima facie case of obviousness. Since the Examiner has not addressed all of the limitations and the Examiner has not responded to Appellants' argument, we are constrained to reverse the Examiner's rejection of independent claim 14 and its dependent claim 15.

With respect to independent claims 24 and 32, Appellants merely argue the motivation for the combination of Open eBook and Tada and Appellants do not show error in the Examiner's statement for the combination of teachings. Therefore, Appellants have not shown error in the Examiner's initial showing of obviousness of independent claims 24 and 32. Since Appellants have not separately argued dependent claims 25-31 and 33-34, we will group these claims as falling with their respective independent claims. We note that dependent claim 35 is directed to the same scope as independent claim 32 and has not been separately argued. Therefore, we will group with independent claim 32.

V. CONCLUSION

For the aforementioned reasons, the Appellants have shown error in the Examiner's initial showing of obviousness of claims 1-9 and 12-15, but have not shown error in the Examiner's initial showing of obviousness of claims 10, 11, and 16-35.

VI. ORDER

We reverse the obviousness rejection of claims 1-9 and 12-15 and affirm the obviousness rejections of claims 10, 11, and 16-35.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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